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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/508,852	06/02/2000	ANTOON JOHANNES GERARDUS VAN ROSSUM	05032.86955	8871

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EXAMINER

KORNAKOV, MICHAIL

ART UNIT PAPER NUMBER

1746

DATE MAILED: 05/23/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/508,852

Applicant(s)

ANTOON JOHANNES GERARDUS
VAN ROSSUM

Examiner

Michael Kornakov

Art Unit

1746

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 08 May 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. **ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).**

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 30-49.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Continuation of 5. does NOT place the application in condition for allowance because: of the reasons set forth in the Final Office Action on the merits. The crux of Applicants' arguments is that EP'498 does not teach a removable with a removing agent protective coating on substantially transparent substrate.

In response to this, Applicants' attention is respectfully drawn to the abstract of EP'498, that recites "alkali soluble film", as well as to page 31, lines 29-34, which discuss the removability of adhesive coating. The most important citation of EP'498 is provided on page 43, lines 25-27 "The polymerized product can be used for a temporarily protecting film and so forth by taking advantage of its alkali-solubility".

Applicants further argue that depending on the Application, the polymers are different from each other and that there is no guidance in EP'498 to select the polymer of the instant claims for use as a protective coating. In response to this, it is first noted that the instant claims 30-37 do not say a single word about the chemical nature of monomers forming a polymer binder, but rather elaborate on its properties, which are either expressly or inherently met by the disclosure of EP'498, as per In re Spada, discussed in the final office action. On page 7, line 55 acrylic acid based polymer is discussed, styrene and methyl methacrylate are disclosed as comonomers on page 8, lines 40-42, it is further noted that on page 48, lines 15-17 show the coating of a polyethylene plate with disclosed composition. This reads on the limitation of substantially transparent substrate of the instant claims. With regard to Applicants' statement that each and every element should be anticipated by the prior art, it is noted that a reference anticipates a claim, if it discloses the claimed invention such that a skilled artisan could take this teaching in combination with his own knowledge of the particular art and be in possession of the invention, as per In re Graves, 36 USPQ 2d 1697 (Fed. Cir. 1995), or In re Sasse, 207 USPQ 107 (CCPA 1980).

And furthermore, the disclosure in a reference must show the claimed elements arranged as in the claim, but need not be in identical words as used in the claim to be anticipatory. In re Bond, 15 USPQ 2d 1566 (Fed. Cir. 1990).

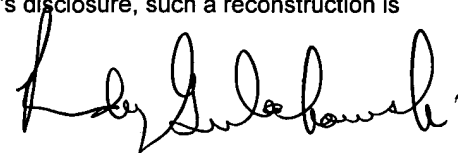
And the last with regard to Applicants statement about the fact that EP'498 does not disclose coatings, Applicants attention is drawn to their own disclosure on page 3, wherein it is clearly stated that EP'498 discloses coatings and to page 1 of the instant specification, wherein elaboration is provided that in order to be a protective coating it must possess an adhesion to the walls of the surface. This particular property is disclosed by EP'498.

With regard to rejection under 35 USC 102/103 over EP'067, Applicants arguments are based on two issues a) that the only example of a polymer is that of styrene and maleic anhydride, which is not a polymer of the instant claims, and b) on a Declaration of Mr. Bertels, that allegedly shows that polymer of EP'067 is outside the scope of instant claims, and that it has disadvantages compare to the polymers of the instant claims. It is first noted that evidence presented to rebut prima facie case of obviousness must commensurate in scope with claims to which it pertains, not with the material presented in the reference; evidence offered by way of affidavit that is considerably narrower in scope than claimed subject matter is not sufficient to rebut PTO's prima facie case, In re Dill, 202 USPQ 805 (CCPA 1979). Furthermore, the Declaration states that the binder of the instant claims has superior characteristics compare to those of EP'067. However, the instant specification does not provide any comparison of characteristics of obtained binders with the binders of prior art. Nor did the Declaration under 37 CFR 1.132 presented a valid side-by-side comparison between their binders and those disclosed by EP'067, as per In re Dunn, 349 F. 2d 433, 146 USPQ 489 (CCPA 1965).

With regard to rejection of claims 39 and 40 over EP'367 in view of EP'067, Applicants arguments are that the hindsight is used in combining the two patents in terms of remedy the deficiency of the pigment absence, and that there is no motivation to combine these references. Based on the similarity of the used binders in terms of their chemical structure and properties, their intended uses, removability by alkaline solution, one skilled in the art would have found it obvious based on the suggestion of EP'367 to include a pigment of EP'067 into a binder composition of EP'367 to impart the solar resistance properties to this composition along with already existing property of acid rain resistance. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See In re McLaughlin, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

M.K.

05/21/2003



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